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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,022	12/26/2001	Michael Roberts	00216-368004	2417

26161 7590 04/30/2003

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EXAMINER

SPISICH, MARK

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 04/30/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,022

Applicant(s)

ROBERTS ET AL

Examiner

Mark Spisich

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1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-37 and 45-55 is/are pending in the application.
- 4a) Of the above claim(s) 33-37 and 45-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 52-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 33-37 and 45-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 33-37 and 45-51, drawn to a process of making a toothbrush bristle, classified in class 264, subclass 172.15.
- II. Claims 52-55, drawn to an oral brush, classified in class 15, subclass 167.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the process of invention I cannot make the product of invention II (only a subcombination thereof). In addition, none of the bristles of invention II need be a coextrusion.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Celia H. Leber (with examiner Tentoni, GAU 1732) on 13 February 2003 a provisional election was made without traverse to prosecute the invention of Group II, claims 52-55. Affirmation of this election must be made by applicant in replying to this Office action. Claims 33-37 and 45-51 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Comment Re Prior Art

Each of the prior four(4) applications included numerous documents with some differences (in view of the fact that the prior application each were drawn to a slightly different aspect of the invention). The examiner has made an effort to cite the prior art from the co-pending applications. If applicant wishes to add any further documents, they are invited to provide them on a form "1449".

Specification

5. The disclosure is objected to because of the following informalities: note the missing text on page 7 (the missing formulas).

Appropriate correction is required.

Notice of Informal Examiner's Amendment

The status of 09/660,151 was updated (ABN) and the final occurrence of "continuation" was changed to – continuation-in-part – (in the insert at page 1).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 52-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,151,745. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the noted claims of the present application and further wherein any differences between the claims of the patent and the application (claims 53 and 54) would be obvious to one having ordinary skill in the art.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Libby (USP 1,251,250) in view of Michaels (USP 5,040,260). The patent to Libby discloses an oral brush comprising a handle (1), head portion (2) and a brush portion comprising

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(a) a plurality of elastomeric bristles (14) extending from the head portion; and (b) a plurality of non-elastomeric bristles (7) extending from the head portion. The patent to Libby discloses the invention substantially as claimed with the exception of the specific material of the elastomer. The patent to Michaels discloses a an oral brush with a brush portion comprising a plurality of elastomeric bristles/projections (10,12) of SANTOPRENE (see column 5, line 2), which is the preferred "polyolefin elastomer" of the present application (see page 7, line 3). Given the disclosure of the preferred material as well as its use in an oral environment, any differences in the material properties (if any) would be obvious to one having ordinary skill in the art as optimization of a prior art device does not constitute a patentable step.

10. Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavone et al (USP 5,325,560) in view of Modic (USP 5,723,543). The patent to Pavone discloses an oral brush (10) comprising a handle (13), head portion (15) comprising at least one elastomeric element (the two opposed sides of the bumper 38 constitute a pair of elastomeric elements along a longitudinal outer edge of the head portion: claims 53-54) as well as a plurality of non-elastomeric bristles (16). The patent to Pavone discloses the invention substantially as claimed with the exception of the specific elastomer. The patent to Modic discloses a an elastomeric styrenic block copolymer which may, among other things, be used to constitute a portion of a toothbrush body (see column 4, line 27). It would have been obvious to one of ordinary skill to have modified the device of Pavone as such as the material of Modic is well suited to overmolding, which a well known method of making dual-material toothbrush bodies.

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With regard to the material properties, they could be arrived at by one of ordinary skill through routine experimentation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (703) 308-1271. The examiner can normally be reached on M-Th (6-3:30), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (703) 308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark Spisich
Primary Examiner
Art Unit 1744

MS
April 28, 2003